

Remarks

Claims 1-10, 12-21, 23-31, and 33-315 are pending in the application. Claims 36, 38, 43, 47 and 49 are sought to be amended. This amendment is not believed to include any new matter, and its entry is respectfully requested.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections, and that they be withdrawn.

Rejections Under 35 USC § 103

In paragraphs 4-9, the Examiner has rejected the claims under 35 U.S.C. § 103 based on a five reference combination of U.S. Patent No. 6,141,666 to Tobin; U.S. Patent No. 5,710,889 to Clark; U.S. Patent No. 5,787,403 to Randle; U.S. Patent No. 6,349,290 to Horowitz; and U.S. Patent No. 6,513,019 to Lewis. Applicant respectfully disagrees, and traverses these rejections.

It does not appear that the Examiner has fully responded to the amendments and remarks made in Applicant's last Reply filed January 16, 2004. It appears that the Examiner's response to those amendments and remarks was to add the Lewis patent to the Tobin+Clark+Randle+Horowitz combination, to thereby form a new five reference combination of Tobin+Clark+Randle+Horowitz+Lewis. The Examiner rejected all of the claims based on this new five reference combination. However, as described below, Lewis does not solve the deficiencies of Tobin, Clark, Randle and Horowitz, considered alone or in combination. Also, as also described below, Applicant respectfully asserts that it is improper to combine these references to form the § 103 rejection.

Applicants also note that it does not appear that the Examiner is giving full weight to the features of the currently pending claims. While the Examiner in paragraph 2 of the Office Action acknowledges Applicant's claim amendments of the Reply filed January 16, 2004, the Examiner in paragraphs 4-9 continues to refer to claim language that was previously amended or deleted by prior amendment. For example, in paragraph 6 of the Office Action, the Examiner refers to the following claim features:

“where each response labeled to correspond to a labeled communication set to each of the plurality of claims”

“each response comprises a unique label to identify each response as coming from a particular client”

“each response comprises a non purchase response option information”

“inputting the response option information and corresponding client identification into an automated reply generation system”

“where each reply comprises a label corresponding to the unique label of its corresponding response”

None of these claim features are recited in any of the pending independent claims. It appears that the Examiner is continuing to examine the claims as originally filed, as opposed to the claims in their current form.

As discussed in Applicant's last Reply filed January 16, 2004, the claimed embodiment is directed to customized marketing of financial products and services. Marketing communications are received by customers and/or non-customers. These marketing communications are related to financial products and/or services that are being offered to customers as part of a marketing campaign. The invention allows for individualized back-and-forth conversations with customers as part of these customized marketing campaigns.

The claimed invention differs from what is taught and suggested in Tobin, Clark, Randle, Horowitz and Lewis, considered alone or in combination.

Consider Horowitz. Horowitz appears to teach an advice engine and a presentation engine for interacting with a customer on a one-on-one basis. Horowitz appears to generate advice for a given customer based on a customer profile. Such advice is then presented to the customer by the presentation engine.

As is currently understood, Horowitz could be viewed as emulating the one-on-one interaction one would have with a bank teller or financial advisor. Such one-

on-one interaction could be seen as a customer visiting her local financial advisor, and having a conversation where the financial advisor offers advice. In Horowitz, such interaction occurs electronically. However, the analogy appears valid.

In contrast to the invention, Horowitz is not directed to marketing campaigns. Horowitz dispenses advice to customers only on a one-at-a-time basis, after the customers are already engaged, not on a mass marketing basis. Unlike the invention, Horowitz does not teach or suggest marketing campaigns that involve the offering of financial products and services.

The claims particularly recite this aspect of the claimed embodiment. For example, claim 1 recites:

A method for automatically preparing customized replies to responses from one or more consumer entities, the method comprising:

receiving one or more responses from one or more consumer entities, said responses being in response to mass *marketing* communications relating to offerings for one or more financial products or services *being offered as part of a mass marketing campaign*;

preparing one or more replies, each of said replies specific to one of said responses or a subsequent response and customized for a consumer entity associated therewith, each of said replies having consumer entity-customized content comprising an offering for one or more financial products or services; and

delivering said replies to corresponding consumer entities.

The other independent claims comprise one or more of such recitations.

Tobin, Clark and Randle do not solve the deficiencies of Horowitz. Tobin appears to teach an Internet portal from which a user can navigate to web sites selling various products. Clark appears to teach an interface device for providing users with access to a plurality of financial services. Randle appears to teach a banking service platform that provides users with access to banking services. These references, considered alone or in combination, are not directed to marketing communications or the marketing of financial products or financial services. Additional differences

between the invention and Tobin, Clark, and Randle are presented in the prior Reply filed on June 6, 2003.

The newly applied Lewis patent does not solve the deficiencies of Tobin, Clark, Randle and Horowitz, considered alone or in combination. Lewis appears to teach a computer system that consolidates financial data, derives information from the data, structures the data and information in a database that enables near real time information access, and distributes the data and information to users and software applications.

In contrast to the claimed invention, Lewis is not directed to marketing communications or the marketing of financial products or financial services. It appears Lewis is used for risk management activities. Unlike the invention, Lewis is not directed to marketing and selling activities.

In support of the rejection, the Examiner cites col. 4, lines 37-43 of Lewis, that states:

What is needed is a current, integrated, accurate and comprehensive information management system providing consolidated transaction, position, balance, market data, and customer/counterparty data ("consolidated information") to customers, employees, and counterparties of the firm within a tightly controlled time period – ideally in real-time.

This teaching of Lewis does not teach or suggest the customized marketing features of the claimed invention. For example, Lewis does not teach or suggest "mass marketing communications relating to offerings for one or more financial products or services being offered as part of a mass marketing campaign" or "said replies having consumer entity-customized content comprising an offering for one or more financial products or services" recited in claim 1.

Applicant also respectfully asserts that it is not proper to combine Tobin, Clark, Randle, Horowitz and Lewis. The Examiner does not provide sufficient support for the five reference combination. For example, in supporting the combination of Lewis with Tobin, Clark, Randle and Horowitz, the Examiner states: "The motivation to combine is to teach an integrated comprehensive information management system to provide market data (and consequently marketing data) to

masses of customers as enuciated by Lewis (col. 4, lines 37-43)." Assuming *arguendo* that Lewis provides this teaching, it is unclear how this teaching of Lewis supports a combination of Lewis with the other four references. Thus, Applicant respectfully asserts that the combinations advanced by the Examiner are improper.

Also, as discussed above, even if the combination is proper, the combination does not teach or suggest the claimed invention.

For the above reasons, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Doubling Patenting Rejection

In paragraph 9 of the Office Action (on pages 10 and 11), the Examiner has entered an "obviousness type" double patenting rejection based on U.S. Patent No. 5,987,434. Without acquiescing to the propriety of this rejection, Applicant will file an appropriate terminal disclaimer after receiving an indication of allowable subject matter. Accordingly, Applicant respectfully requests that this rejection be held in abeyance until that time.

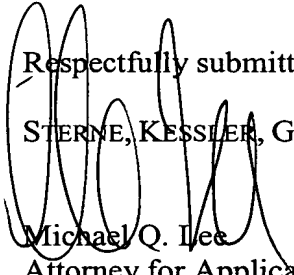
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Michael Q. Lee
Attorney for Applicant
Registration No. 35,239

Date: August 2, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600